

REMARKS**A. Applicant's Election of Group II (Claims 1-34 and 58-71) for Prosecution**

By this amendment, Applicant has canceled claims 35-57. Claims 1-34 and 58-71 remain in the present application.

Applicant hereby elects, without traverse, to prosecute the invention of Group II in response to the restriction requirement set forth in the Office Action dated February 25, 2003. In other words, Applicant elects, without traverse, to prosecute claims 1-34 and 58-71 in the present application. Applicant hereby reserves its right to file a divisional application directed to claims 35-57 which are canceled in this application solely in response to the Examiner's restriction requirement set forth in the Office Action of February 25, 2003.

B. Applicant's Express Election of a Single Disclosed Species and Traverse Under MPEP §818.03

For the purpose of being responsive to the Examiner's request in pages 3-7 of the Detailed Action, and as required by MPEP §809.02(a) and §818.03, Applicant hereby elects, *with traverse*, the embodiment of the invention disclosed in Figures 1 and 2, directed to claims 1-11 (which include generic claim 1), for examination on the merits. It is noted that Figures 1 and 2 are directed to a single embodiment, Figure 2 being a more detailed view of Figure 1. The Examiner has acknowledged the fact that Figures 1 and 2

correspond to a single embodiment in the parent application serial number 09/977,444, filed on October 15, 2001.

Despite the above election of claims 1-11 for prosecution, which election is for the purpose of being responsive to the Examiner's request in pages 3-7 of the Detailed Action and per requirement of MPEP §809.02(a) and §818.03, Applicant respectfully traverses the Examiner's grouping of the subject matter of the present invention into five (5) different species. At the outset, it is noted that according to MPEP §803, the two criteria for a proper requirement for restriction are that (1) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); and (2) There must be a serious burden on the examiner if restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02). As such, Applicant *traverses* the Examiner's restriction requirement and the division of the invention into five (5) "patentably distinct" species as discussed below.

1. There Are No Independent or Distinct Inventions

Applicant respectfully submits that, in the present application, the species identified by the Examiner are not independent or distinct.

In the present application, the disclosed and claimed invention is not directed to different "combinations not capable of use together, having different modes of operation, different functions or different effects." See MPEP §806.04 which recites, by way of example, that an article of apparel such as a shoe is independent from a locomotive

bearing, or that a process for painting a house is independent from a process for boring a well.

The present application is directed to an imager cell with a pinned transfer gate and a readout gate. Figures 1 and 2 are directed to an embodiment including an imager cell having a pinned transfer gate and a readout gate without an aperture. Figure 3 is directed to an embodiment including an imager cell having a pinned transfer gate and a readout gate with an aperture. Figure 4 is directed to an embodiment including an imager cell having a pinned transfer gate and a readout gate without an aperture, but with a thin gate. Figures 5 through 8 provide various illustrations, but do not disclose additional embodiments beyond the three embodiments mentioned above. Applicant respectfully submits that none of the three embodiments mentioned above is directed to subject matter that can be deemed an independent invention within the meaning of MPEP §806.04. The fact that the readout gate may or may not have an aperture and the different thicknesses of the readout gate cannot be said to define independent or distinct inventions. Applicant submits that existence of an aperture in a gate or a thinner-than-normal gate, both for providing increased sensitivity to incident light, are design choices and not independent or distinct inventions.

According to MPEP §806.04(e), the species are independent only when there is no relationship between them. In the present application, there is in fact a relationship between the three embodiments since all three embodiments are directed to an imager cell having a pinned transfer gate and a readout gate. In other words, the claims of the present

invention do not have “mutually exclusive characteristics” as required for a proper restriction requirement under MPEP §806.04(f).

2. There Is No Serious Burden For Prior Art Search

Furthermore, the MPEP requires that there be a serious burden on the examiner if restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02). MPEP §803 emphasizes that: “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Applicant respectfully submits that no additional burden is imposed on the Examiner to conduct a prior art search, since such prior art search need not be directed to a search for different thicknesses of gates or existence (or lack of existence) of an aperture in gates.

Even if Applicant were to file divisional applications directed to the five (5) species identified by the Examiner, “IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION.” See MPEP §803.01 (capitals in original).

3. Applicant’s Express Admission Under MPEP §803

It is noted that “**election of species should not be required if the species claimed are considered clearly unpatentable (obvious) over each other.**” MPEP §808.01(a) (emphasis in original). In any event, “[i]f there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction

should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).” See MPEP §803. As such, Applicant hereby expressly admits that the inventions claimed in claims 1-34 and 58-71 are obvious over each other within the meaning of 35 U.S.C. §103. Due to this express admission alone, Applicant respectfully requests that all 1-34 and 58-71 be considered as pending in the present application.

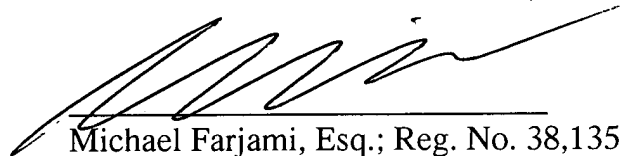
B. Conclusion

In light of the above reasons, Applicant respectfully traverses the Examiner's restriction requirement and requests that all claims 1-34 and 58-71 in the present application be Examined as a single application. In the unlikely event that the Examiner maintains the present restriction requirement, and as required by MPEP §809.02(a) and §818.03, Applicant has made a provisional election of claims 1-11 (which include generic claim 1) for prosecution in the present application.

Please note that Applicant's attorneys have changed. Applicant has filed a "revocation and power of attorney" to formally effect this change. The contact information of Applicant's new attorneys appear below.

Respectfully submitted;

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